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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,084	11/19/2001	Peng Jiang	1789-09300	9640

23505            7590            05/29/2003  
CONLEY ROSE, P.C.  
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HOUSTON, TX 77253-3267

EXAMINER
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LOVERING, RICHARD D

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 05/29/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

*Eric Rhoten*

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<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/992,084	JIANG ET AL
Examiner	LOVERING	Group Art Unit 1712

*—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—*

#### Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

#### Status

Responsive to communication(s) filed on APR. 29, 2003.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

#### Disposition of Claims

Claim(s) 10 - 21, 30 - 42 AND 44 is/are pending in the application.

Of the above claim(s) 12 - 15, 18 AND 19 is/are withdrawn from consideration.

Claim(s) 30 - 42 is/are allowed.

Claim(s) 10, 20 AND 44 is/are rejected.

Claim(s) 16, 17 AND 21 is/are objected to.

Claim(s) 10 - 21, 30 - 42 AND 44 are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

#### Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). 5  Interview Summary, PTO-413

Notice of References Cited, PTO-892  Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

#### Office Action Summary

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*to be deleted*

1. Claims 12-15, 18 and 19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected species. Election was made **without** traverse in Paper No. 8.

2. Since the prior art of record doesn't disclose or fairly suggest the method for preparing a second-generation colloid of independent claim 30 herein, the election of species requirement is withdrawn as to said method for preparing only.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 10, 20 and 44 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Norris et al. 6,139,626, esp. Examples 1-6, particularly Example 5. While Norris et al. may not prepare their spherical CdSe colloid by the same process as that used by applicants herein, applicants have not shown that the process terminology recited in the stated instant claims is materially and patentably distinguishing. See In re Marosi, 710 F. 2d 799; and In re Thorpe, 777 F. 2d 695. Further, as to claim 44 herein, Norris et al. state (column 2 lines 52-55) that their products are photonic bandgap materials.

→ 6. Claims 11, 16, 17 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record doesn't disclose or fairly suggest the process for preparing a second-generation colloid of claims 30-42 herein or the second-generation colloids having the limitations of claims 11, 16, 17 and 21 herein.

8. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor

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errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

9. The remaining references listed on the attached Form PTO-1449 and Form PTO-892 are cumulative to the reference applied herein, and/or further show the state of the art.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lovering whose telephone number is (703) 308-0443. The examiner can normally be reached on Mon.-Fri. from 7:30 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

R. Lovering:cde  
May 23, 2003

*Richard D. Lovering*  
RICHARD D. LOVERING  
PRIMARY EXAMINER  
GROUP 1700